

### **REMARKS**

The Applicants thank the Examiner for the thorough examination of the application. No new matter is believed to be added to the application by this reply.

### **Status of the Claims**

Claims 1-12 are pending in the application.

### **Claim Objections**

The Examiner asserts that claims 1, 8 and 12 contain informalities. The Examiner believes that “a print engine having a plurality of trays” should read as “a printer having a plurality of trays.”

However, an Applicant can be his or her own lexicographer. *See MPEP 2173.05*. The print engine 18 is depicted in Figure 2 and is adequately and sufficiently described at page 6, lines 25-30 of the specification. This passage describes the print engine 18 in broad terms. As a result, the Examiner is unnecessarily narrowing the scope of the disclosure when he asserts: “Print engine, which is also an equivalent to a print-head, cannot have a plurality of trays.” When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to

achieve a complete exploration of the applicant's invention and its relation to the prior art. *In re Zletz*, 893 F.2d 319, 13 U.S.P.Q.2d 1320 (Fed. Cir. 1989).

Claims 1, 8 and 12 are accordingly free from informalities.

### **Rejections Based On Hube And Moro**

Claims 1-6 and 8-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hube (U.S. Patent 5,229,814). The Examiner adds the teachings of Moro (U.S. Patent 6,327,051) to the aforesaid rejection to reject claim 7 under 35 U.S.C. § 103(a). Applicants traverse.

### **The Present Invention And Its Advantages**

The present invention, in part, pertains to a printing system having a user interface that is capable of simplifying and speeding up the process of loading the required type of recording sheets. The present invention has many embodiments, but a typical embodiment can be found in claim 1:

1. A digital image production apparatus comprising:
  - a print engine having a plurality of trays each of which is capable of accommodating different types of recording sheets;
  - a user interface; and
  - an electronic control system for controlling print processing, including control of supply of recording sheets from the trays in accordance with sheet specifications of print jobs,
    - wherein the control system has access to a memory which stores for each tray the type of recording sheets presently accommodated therein, and;
    - wherein, when recording sheets of a type required for a job

are not available in any of the trays, the control system:  
indicates, through the user interface, the required type of recording sheet;  
selects an eligible tray that can accommodate the required recording sheets;  
invites, through the user interface, an operator to place recording sheets of the required type in the eligible tray; and  
automatically, in response to receiving a confirmation signal which confirms that the operator has completed the requested action, presumes that the installed recording sheets are of the required type and stores information specifying the required type of recording sheet in a location of the memory associated with said eligible tray.

*Distinctions Of The Invention Over Hube And Moro*

Hube pertains to a "Docutech" printer in which print media of different types may be accommodated in multiple paper trays. Hube basically programs each paper tray in advance for the user interface with the specifications of the media it contains. As a consequence, a print job may simply specify the media it needs, and the printer controller checks if that media is available in any of the trays and if so, assigns the relevant paper tray to the job.

With the occurrence that a specific media specified in a print job is not available in any of the trays, a substitution strategy is followed, which is discussed in detail in Hube. Indeed, the substitution strategy is the main aspect of the Hube patent, because it explicitly refers to Moreno et al. (U.S. Patent 5,081,595) for the basic system description, which is incorporated by reference at column 1, lines 41-53.

According to Figure 7B of Hube, when the printer finds out that the media needed for the current print job is currently not available in any of the trays, it first checks if it is nevertheless available on site. If so, the printer requests the operator to load the requested media in an available, i.e., not yet assigned, tray. However, what exactly the operator is required to do is not described in detail. The relevant passage (Hube at column 9, lines 57-61) simply states that "the operator is directed load the REQUESTED STOCK, and ... the process is paused until the operator takes an appropriate action." The flow sheet of Figure 7B of Hube defines the "appropriate action" as a "STOCK LOAD ACKNOWLEDGEMENT."

Hube, that is, fails to provide a sufficient description to anticipate or suggest the present invention.

Firstly, the Docutech described in Hube has three paper trays, and this machine should at least be informed of the tray selected by the operator for loading the requested media. Otherwise, the machine would not know which tray to assign. Clearly, such a step must necessarily be present, but is not disclosed.

Second, Hube fails to disclose if the tray chosen is actually reprogrammed for its new contents or is simply assigned to the print job without any internal reference to the particular requested media. This failure

would be of little importance for the current print job, but what would happen in thte next print job?

Since the disclosure of Hube is incomplete, one would look for more information in the incorporated Moreno patent, which was made of record in the instant application in the Information Dislcosure Statement filed May 4, 2001. Moreno describes the situation at column 8, lines 8-38.

Moreno discusses that when the media required for the active print job is not available in any of the trays, the printer asks the operator through its display, to load that media in a specific tray. When the operator does so, the operator still has to put the media particulars (apart from paper size which is automatically detected) at the user interface (see Moreno at column 9, lines 24-31).

Hube thus describes the Moreno system with a set of additional features, where these additional features are of no relevance to the present invention. Indeed, these features are the only referred to in the Office Action.

Thus, it is clear that the Hube or Hube/Moreno clearly fails to disclose or suggest the digital image production apparatus that "automatically, in response to receiving a confirmation signal which confirms that the operator has completed the requested action, presumes that the installed recording sheets are of the required type and stores information specifying the required

type of recording sheet in a location of the memory associated with said eligible tray.” (Claim 1 of the present invention). Independent claims 8 and 12 are similarly definable over Hube.

Since inputting media specifications takes time and may include errors, the present invention is advantageous compared to the prior art by eliminating that inputting step. Therefore, independent claims 1, 8 and 12 are clearly not anticipated by Hube. Claims depending upon independent claims 1, 8 and 12 are patentable for at least the above reasons.

The Examiner turns to Moro for teachings pertaining to user terminals to reject claim 7. However, Moro fails to address the deficiencies of Hube in anticipating or suggesting the present invention. A *prima facie* case of obviousness has thus not been made over claim 7.

These rejections are overcome and withdrawn thereof, it is respectfully requested

### **Prior Art**

The prior art cited but not utilized by the Examiner indicates the status of the conventional art that the invention supersedes. Additional remarks are accordingly not necessary.

Application No.: 09/848,297  
Response of June 28, 2005  
Reply to Office Action of March 28, 2005

Docket No.: 0142-0352P

### **Information Disclosure Statement**

The Applicants thank the Examiner for considering the Information Disclosure Statement filed May 4, 2001, and for making the initialed PTO-1449 form of record in the Office Action mailed March 28, 2005.

### **Drawings**

The Examiner is respectfully requested to indicate whether the drawing figures are acceptable in the next Official Action.

### **Priority**

The Examiner has acknowledged foreign priority in the Office Action mailed March 28, 2005.

### **CONCLUSION**

The Examiner's objections and rejections have been overcome, rendered moot or obviated. No issues remain. The Examiner is accordingly respectfully requested to place the application in condition for allowance and to issue a Notice of Allowability.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Registration No. 42,593) at the telephone number of

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the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Dated: June 28, 2005

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